

REMARKS

The Final Office Action dated December 9, 2010, has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 13-18 and 20-23 are presently pending in the instant application. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 13-14, 16-18, and 20-23 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Martensson (U.S. Patent No. 6,146,252) in view of Piacente *et al.* (U.S. Patent No. 5,858,160, hereinafter, "Piacente"). Martensson and Piacente, however, fail to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the claims over from the prior art in different ways. For example, independent claim 13 recites a combination that includes, among other things:

"[a] laminated floor board comprising at least one cellulose sheet impregnated with a resin that is mechanically pressed and cut into a product, said product having a fiberboard core, wherein the product includes a surface, the product having both a perimeter area having an edge contour and an interior region, wherein the perimeter area is relieved such that a portion of the edge contour is below the interior region, wherein the interior region has a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, wherein the visual pattern imitates another product."

Independent claim 17 recites yet another combination that includes, *inter alia*,

"[a] laminated product that has been mechanically pressed and cut to form individual units thereof, each individual unit including a surface having an interior region and an edge contour region, wherein at least a portion of the edge contour region has been pressed below the interior region, wherein the interior region has a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, wherein the visual pattern imitates another product."

Independent claim 21 recites a further combination that includes, for instance,

"[a] laminated product unit, comprising . . . a cellulose core including a plurality of cellulose sheets, said cellulose sheets including at least one resin-impregnated cellulose sheet having a printed design . . . depressed deformities extending from an upper surface of said cellulose core, said depressed deformities

corresponding with the printed design . . . a perimeter rim including at least one depressed edge region."

At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 13, 17, and 21.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Martensson and Piacente, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. See M.P.E.P. § 2143 (8th ed. 2007). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Martensson, the base reference, based on the teachings of Piacente, the secondary reference, in a manner that could somehow result in the claimed invention. See *id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Martensson in a manner that could somehow result in the claimed invention. See *id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. See *id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Martensson, taken alone or in combination with Piacente, can either

anticipate or render obvious each and every one of the limitations present in independent claims 13, 17 and 21 as required by the M.P.E.P. and Federal Circuit jurisprudence.

Turning to page 3 of the outstanding Office Action, the Examiner readily admits that *“Martensson does not disclose the laminated material to have a surface texture that varies in accordance with the visual pattern that imitates another product.”* The Examiner then turns to the disclosure of Piacente in an attempt to remedy the deficiencies of Martensson. However, as previously argued in, at least, the response filed January 12, 2009, the Examiner cites two separate sections of Piacente – Col. 3, lines 26-28 and Col. 1, lines 53-57. However, it is expressly noted that neither cited passage actually refers to teaches or suggests, *inter alia*, *“a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, wherein the visual pattern imitates another product”* even if these cited passages are read together, as the Office Action appears to do. Reading these passages as modifying each other is improper (emphasis added) at least because Col. 3, lines 26-28, refers to the Present invention,” while Col. 1, lines 53-57 refers to “common practice.” These teachings cannot be properly combined, especially since the patent itself disparages the “common practice” in favor of the “present invention.” Regardless, there still is no teaching of a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, *e.g.*, the texture of the exterior face that is compatible with an observable design.

Moreover, it is not possible to combine Piacente and Martensson to achieve laminate floor boards having the features recited in, at least, claims 13, 17 and 21. Piacente notes that it “require[s] a foamable layer, as in the case of the method aspects of a foamed layer, as in the case of the product aspects. The foamable compositions and layers of the present invention are characterized by an ability to produce, after appropriate foaming steps, a blown or foamed,

cellular structure” (Piacente, col. 3, lines 47-52). Piacente goes on to describe the foamable layers contemplated by its invention: “the foamable layer of the present invention preferably comprises a foamable composition containing polyvinyl chloride (PVC) resin, and even more preferably a foamable PVC plastisol composition” (Piacente, Col. 3, lines 55-59).

Thus, Piacente is not directed to a “laminated floor board comprising at least one cellulose sheet,” as recited, for example in claim 13 and similarly in claims 17 and 21. Furthermore, the structures in Piacente, including foamable compositions and layers and PVC resin are not cellulose sheets, as claimed. Piacente, is not directed to laminate floor boards of the present invention nor is it directed to the laminate floor boards of Martensson and, hence, is therefore considered to be non-analogous art as related to Martensson and/or the present invention. The structures and processes for achieving the surface characteristics of the products in Piacente are not applicable to the laminates of Martensson, nor could the structures of Piacente be applied to Martensson without considerable and undue experimentation, if at all, particularly in the context of a thermosetting laminate structure of Martensson. Thus, it is not possible to properly combine Piacente and Martensson to achieve laminate floor boards having the features recited in claims 13, 17 and 21.

The Examiner has previously stated (e.g., page 2 of Office Action mailed August 31, 2009), that *“Piacente is not relied upon for its teaching of the method of embossing, but rather for the teaching of embossing in register with a visual pattern . . . [o]ne of ordinary skill in the art upon review of the cited references would be motivated to pursue known embossing techniques to achieve a laminate floor (as claimed and disclosed by Martensson) to have a surface embossed in accordance with a visual pattern (as disclosed by Piacente).”* However, Applicant respectfully asserts that one of ordinary skill in the art would not modify Martensson

to provide a visual pattern, since doing so would change the principle operation of Martensson, thereby rendering Martensson unsatisfactory for its intended purpose. As directed by MPEP 2143.01(V), “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” Moreover, as directed by the M.P.E.P. § 2143.01(VI), “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” Thus, Applicant respectfully asserts that modifying Martensson with the alleged teachings of Piacente is not sufficient to render Applicant’s claimed invention *prima facie* obvious.

Furthermore, the purported prior art combination fails to teach or fairly suggest, *inter alia*, “the perimeter area having an edge contour and interior region,” as recited in claim 13 and similarly in claims 17 and 21. Applicants specification defines that avoiding the pressure from contact by users at the relieved perimeter area results in the improved wear resistance of the invention. Notably, paragraphs [0006]-[0007] of corresponding U.S. Patent Application Publication No. US 2004/0144051 A1 describe that one issue with the prior art is poor wear resistance because users’ shoe soles contact both the center of a tile and the perimeter edge. Specifically, it explains that the perimeter edge is generally the weakest area so contacting the edge will cause that area to deteriorate first. The present invention address the aforementioned concerns by allowing the interior region to preferably bear most of the pressure, for example, from the user’s shoes. If, for example, the interior region only has a small intermittent portions protruding above the perimeter area, the perimeter area would received the same or more

pressure from the user's shoes. Thus, an important aspect of the claimed invention includes that the perimeter area is relieved below a portion of the interior region as claimed.

At best, Martensson merely discloses chamfering and an edge of a board (e.g., see FIG. 2, Col. 1, lines 33-34, and Col. 2, lines 31-36 of Martensson). Martensson, however, is silent with regards to providing any disclosure of the perimeter area as claimed. Again, Piacente fails to cure the deficiencies of Martensson, for example, by disclosing a relieved perimeter area as claimed by the present invention.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Martensson nor Piacente, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 13, 17, and 21. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 13, 17, or 21 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 13, 17, and 21. In addition, each of the dependent claims also recites combinations that are separately patentable.

In view of the foregoing remarks, the claims are not rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

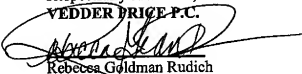
In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 22-0259. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent attorney at (202) 312-3366.

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